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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re **Magnetic Ticket & Label Corp.**

Serial No. 76390088

Gregory C. Smith, Charles C. Garvey, Jr., Seth M. Nehrbass, Stephen R. Doody and Brett A. North of Garvey, Smith, Nehrbass & Doody, L.L.C. for Magnetic Ticket & Label Corp.

Caroline F. Weimer, Trademark Examining Attorney, Law Office 115 (Tom Vlcek, Managing Attorney).

Before Seeherman, Quinn and Holtzman, Administrative Trademark Judges.

Opinion by Seeherman, Administrative Trademark Judge:

Magnetic Ticket & Label Corp. has appealed from the final refusal of the Trademark Examining Attorney to register ZIPCARD as a trademark for "card with activation control."¹ Registration has been refused on three bases:

1) the identification of goods is indefinite;

¹ Application Serial No. 76390088, filed April 2, 2002, based on an asserted bona fide intention to use the mark in commerce.

2) applicant's mark so resembles the mark ZIP CARD, registered by The University of Akron for both "magnetically coded debit cards"² and for "credit and debit card services"³ that, if used on applicant's identified goods, it is likely to cause confusion or mistake or to deceive; and 3) that applicant's mark is merely descriptive of its identified goods.

Applicant and the Examining Attorney have filed briefs; applicant did not request an oral hearing.

We turn first to the requirement for an acceptable identification of goods. The Examining Attorney has objected to the identification "card with activation control" as being indefinite and overbroad. Applicant did not address this objection in its response to the first Office action; further, although the Examining Attorney pointed out this omission in the second and final Office action, applicant did not make any reference to the objection in its brief. Applicant's silence on this matter could be taken as a concession that the Examining Attorney's position is correct.

In any event, we agree with the Examining Attorney that applicant's identification of "card with activation

² Registration No. 2428152, issued February 13, 2001.

³ Registration No. 2428163, issued February 13, 2001.

control" is indefinite and overbroad. See Section 1402.01 of the Trademark Manual of Examining Procedure (TMEP), 3d ed. (rev. May 2003), which provides, in part:

A written application must specify the particular goods or services on or in connection with which the applicant uses, or has a bona fide intention to use, the mark in commerce. 15 U.S.C. §§1051(a)(2) and 1051(b)(2); 37 C.F.R. §2.32(a)(6). To "specify" means to name in an explicit manner. The identification of goods or services should set forth common names, using terminology that is generally understood. For products or services that do not have common names, the applicant should use clear and succinct language to describe or explain the item. Technical or esoteric language and lengthy descriptions of characteristics or uses are not appropriate.

The language used to describe goods or services should be understandable to the average person and should not require an in-depth knowledge of the relevant field. An identification may include terms of art in a particular field or industry, but, if these terms are not widely understood by the general population, the identification should include an explanation of the specialized terminology.

The identification of goods or services must be specific, definite, clear, accurate and concise. See *In re Societe Generale des Eaux Minerales de Vittel S.A.*, 1 USPQ2d 1296 (TTAB 1986), *rev'd on other grounds*, 824 F.2d 957, 3 USPQ2d 1450 (Fed. Cir. 1987); *Procter & Gamble Co. v. Economics Laboratory, Inc.*, 175 USPQ 505 (TTAB 1972), *modified without*

opinion, 498 F.2d 1406, 181 USPQ 722 (C.C.P.A. 1974); In re Cardinal Laboratories, Inc., 149 USPQ 709 (TTAB 1966); California Spray-Chemical Corp. v. Osmose Wood Preserving Co. of America, Inc., 102 USPQ 321 (Comm'r Pats. 1954); Ex parte A.C. Gilbert Co., 99 USPQ 344 (Comm'r Pats. 1953).

See also, TMEP §1402.03 (A term that clearly includes particular items that are classified in more than one class (e.g., "artists' materials") is not acceptable.) Here, as the Examining Attorney has explained, applicant's cards could be classified in Class 9 if magnetically encoded or in Class 16 if they do not have magnetic coding. Further, the term "cards" is so broad that it is not clear from the identification what the nature of applicant's cards is.

Accordingly, we affirm the requirement for a definite identification of goods.

We turn next to the issue of likelihood of confusion. This ground of refusal is based on Section 2(d) of the Trademark Act, 15 U.S.C. 1052(d). Our determination is based on an analysis of all of the probative facts in evidence that are relevant to the factors set forth in In re E. I. du Pont de Nemours & Co., 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). See also, In re Majestic Distilling Company, Inc., 315 F.3d 1311, 65 USPQ2d 1201 (Fed. Cir. 2003). In any likelihood of confusion analysis, two key

considerations are the similarities between the marks and the similarities between the goods and/or services. See *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24 (CCPA 1976). See also, *In re Dixie Restaurants Inc.*, 105 F.3d 1405, 41 USPQ2d 1531 (Fed. Cir. 1997).

With respect to the goods, despite the indefiniteness of applicant's identification, that is the identification which we must consider in making our determination. Applicant's goods, as identified, are broad enough to include debit cards with activation control. Moreover, it is clear that such items are, in fact, some of the goods on which applicant intends to use its mark, as applicant has actually listed "debit card with activation control" as its "goods/services" on the drawing page of its application.

There is no question that a "debit card with activation control" is encompassed within the "magnetically coded debit cards" identified in cited Registration No. 2428152. Further, such a debit card is closely related to the "credit and debit card services" identified in the second cited registration. It is obvious that a company which provides credit or debit card services may also provide credit or debit cards to access such services.

Applicant argues that its cards are different from the registrant's because its cards can be purchased anywhere, and can then become activated at the point of purchase, while it asserts that the registrant's cards are purchased on the campus of The University of Akron and are used solely within the geographic area of the campus and in no other places. Applicant has not submitted any evidence in support of its contention, and its argument is contradicted by the fact that affinity cards, such as those identifying a college, may be offered to people throughout the country. More importantly, applicant has ignored the well-established principle of trademark law that the question of likelihood of confusion must be determined based on an analysis of the mark as applied to the goods and/or services recited in the applicant's application vis-à-vis the goods and/or services recited in the cited registration. See *Canadian Imperial Bank of Commerce v. Wells Fargo, N.A.*, 811 F.2d 1490, 1 USPQ2d 1813 (Fed. Cir. 1987); see also, *In re Dixie Restaurants Inc.*, 105 F.3d 1405, 41 USPQ2d 1531 (Fed. Cir. 1997).

Accordingly, we must deem the registrant's goods and services, which are not restricted geographically or to any specific trade channels, to encompass all appropriate trade channels in which debit cards and debit and credit card

services can be offered. The customers would include stores of all types, as well as the public at large, which are the customers to which applicant's cards, as identified, can be offered.

With respect to the marks, applicant has conceded that the mark "ZIP CARD of the registrant is similar in sound and view to the ZIPCARD of applicant." Brief, p. 3. We find that the marks are identical in sound and connotation, and extremely similar in appearance. Although applicant has pointed out that its mark is one word, while the cited mark is two words, this small difference is not sufficient to distinguish the marks. Consumers will readily recognize that applicant's mark is composed of the two words ZIP and CARD, such that both marks convey the same commercial impression. Further, consumers are not likely to remember that applicant's mark is depicted as one word and the registrant's mark as two. Under actual marketing conditions consumers do not have the luxury to make side-by-side comparisons between marks, and instead they must rely on hazy past recollections. *Dassler KG v. Roller Derby Skate Corp.*, 206 USPQ 255 (TTAB 1980). Even if consumers were to note that one mark is shown as one word while the other mark is shown as two, they are not likely to ascribe this minor difference to a difference in the

sources of the respective goods and services. Rather, a consumer who is familiar with the registrant's ZIP CARD for a magnetically coded debit card or for debit card services, upon encountering ZIPCARD for a debit card with activation control, will assume that ZIPCARD is merely a variation of ZIP CARD.

It is also noted that applicant has conceded that "the buyers may be considered impulse." Brief, p. 3. Certainly ordinary consumers, buying the debit cards on impulse, are not likely to engage in a careful consideration of the marks, to the point of questioning whether the presence or absence of a space between ZIP and CARD indicates that the identical goods, and closely related goods and services, emanate from separate sources.

With respect to the remaining duPont factors, although there is no evidence of actual confusion, applicant has conceded that "the length of time of concurrent use is brief." In fact, there is no evidence that applicant has used its mark at all, as this application is based on Section 1(b) of the Trademark Act, applicant has not filed an Amendment to Allege Use, and applicant has provided no information as to when it may have commenced use, or the extent of any such use. In any event, proof of actual confusion is very difficult to obtain, and in an ex parte

setting, with no information from the registrant as to its experience as to any actual confusion, we do not give much weight to the lack of evidence of actual confusion.

For the foregoing reasons, and particularly the similarity of the marks and the identity of the goods and the closely related nature of the goods and services, we find that applicant's mark, if used on its identified goods, is likely to cause confusion with the two cited registrations, and we affirm the refusal of registration on this ground.

This brings us to the remaining ground for refusal, that applicant's mark is merely descriptive of its goods. It is the Examining Attorney's position that ZIP CARD is merely descriptive because it indicates the manner in which debit data is compressed on the card. In support of this refusal, the Examining Attorney has made of record a definition for "zip," taken from an on-line "high-tech" dictionary: "To compress a file using PKZIP, Zipit, gzip, or other compatible archiver."⁴

A term is merely descriptive, and therefore prohibited from registration by Section 2(e)(1) of the Trademark Act, 15 U.S.C. §1052(e)(1), if it immediately conveys knowledge

⁴ <http://www.computeruser.com/resources/dicitionary/definition/html?lookup=5724>

of the ingredients, qualities or characteristics of the goods with which is it used. In re Gyulay, 820 F.2d 1216, 3 USPQ2d 1009 (Fed. Cir. 1987). In this case, it is not clear that data is compressed on cards with activation control, or that the term ZIPCARD, when used on such cards, would immediately be recognized as referring to cards in which data has been compressed. Aside from the dictionary definition, the Examining Attorney has not submitted any other evidence showing that "zip" is used in such a manner. In view of the non-technological meanings of "zip", e.g., "to move or act with speed or energy, to convey with speed and energy,"⁵ all of which suggest that using applicant's card can speed the purchasing process, we cannot say that the meaning the Examining Attorney has put forward is the meaning that consumers would immediately ascribe to the mark. Therefore, we cannot affirm the refusal on the ground of mere descriptiveness.

Decision: The requirement for an acceptable identification of goods and the refusal to register the mark on the basis of likelihood of confusion are affirmed;

⁵ The Random House Dictionary of the English Language, 2d ed., unabridged, © 1987. The Board may take judicial notice of dictionary definitions. *University of Notre Dame du Lac v. J. C. Gourmet Food Imports Co., Inc.*, 213 USPQ 594 (TTAB 1982), *aff'd*, 703 F.2d 1372, 217 USPQ 505 (Fed. Cir. 1983).

Ser No. 76390088

the refusal on the basis of mere descriptiveness is reversed.